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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/13/2005

Jun Sakamoto

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EXAMINER

MESH, GENNADIY

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,847	Applicant(s) SAKAMOTO ET AL.	
	Examiner GENNADIY MESH	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8 and 13-52 is/are pending in the application.
- 4a) Of the above claim(s) 20-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2009 has been entered.

1.2. No amendments to claims were presented by Applicant. Claims 1, 8 and 13 -19 are active. Claims 20 - 52 have been withdrawn.

Response to Amendment

2. The Declaration under 37 CFR 1.132 filed December 22, 2008 is **insufficient to** overcome the rejection of claims 1,8 and 13-18 based upon Aoyama combine with Naylor as set forth in the last Office action because data provided by Declaration (see Table on page 5) is not commensurate with Scope of the claims for following reason:

Data (see Table) is irrelevant to limitation of Claim as " wherein the number of titanium-containing particles having an equivalent circular diameter of **1 micron** or more is less than 100/0.02 mg of the composition" because no compounds with particles size more than 1 micron presented in Table.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1,8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) in view of Naylor et al.(WO 97/47675) combine with Kato et al.(US 6,680,353).

The rejection is adequately set forth in paragraph 1 of the action mailed April 8,2008 and is incorporated here by reference.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) in view of Naylor et al.(WO 97/47675) combine with Kato et al.(US 6,680,353) as it applied to claims 1, 8 and 13-18 above, and in further view of Uchida et al.(US 6,670,030).

The rejection is adequately set forth in paragraph 2 of the action mailed April 8,2008 and is incorporated here by reference.

Response to Arguments

5. Applicant's arguments filed on January 12, 2009 have been fully considered but they are not persuasive.

5.1. Applicant's arguments related to Claims 1,8 and 13-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) in view of Naylor et al.(WO 97/47675) combine with Kato et al.(US 6,680,353) based on following:

Art Unit: 1796

a) Applicant stated that " To support a rejection of claims of an application under 35 U.S.C. 102 or 35 U.S.C.103 (a), the prior art **must be enabling**".

In response for this argument note, that (see MPEP 2121[R-6]):

Prior art is presumed to be operable/enabling:

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07.

b) and that "The Office has failed to cite teachings in Aoyama or the prior art that would enable a person of ordinary skill in the art to modify the method of Aoyama so as to obtain a polyester resin composition which meets the particle size limitations of the claims of the present application.

In response for this argument note, that rationale based on teaching of Aoyama was clearly stated in previous action and cited by Applicant in instant remarks :

"Aoyama recognized importance of small particle sizes less than 3 micron in order "to achieve good slipperiness and adhesiveness at the time of lamination" - see column 6, lines 1-6. Thus, Aoyama provide rationale to one of ordinary skill to reduce particle size to less than 3 micron in order to achieve good slipperiness and adhesiveness" of the composition."

Therefore, this applicant's argument was found unpersuasive.

Art Unit: 1796

c) Applicant's also argue that Declaration filled on December 22, 2008 demonstrated that " none of the compositions of the examples of Aoyama meet the limitation that the number of titanium-containing particles having an equivalent circular diameter of 1 μ m or more is less than 100/0.02 mg of the *composition*, as required by the claims of the present application".

As it was explained above(see paragraph 20 Declaration was found is **insufficient to** overcome the rejection of claims 1,8 and 13-18.

Therefore, Applicant's argument based on data provided by Declaration is unpersuasive.

d) Applicant's further argue, that : " the comparative data in the present application show that less than 100/0.02 mg of the polyester resin composition of titanium-containing particles having an equivalent circular diameter of 1 μ m or more is material to obtaining a composition having good castability and a reduced number of dropouts°

(Comparative Examples 1 and 4 in Tables i-I and 1-2). These data demonstrate criticalness for the number density of titanium-*containing* particles having an equivalent circular diameter of 1 μ m or more as recited in the claims and rebut any prima facie obviousness alleged by the Office to be supported by the combination of Aoyama, Naylor and Kato" - see page 6, last paragraph and page 7, first paragraph of Remarks.

It is noted that data presented in Table 1-1 and 1-2 is not commensurate with scope of claims, because no actual size of particles presented by data and no examples with

Art Unit: 1796

particles more than 1 micron (for example 100 microns) presented in Tables 1-1 and 1-2.

Therefore, all Applicant's arguments were found unpersuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh
Examiner

Application/Control Number: 10/529,847

Page 7

Art Unit: 1796

Art Unit 1796

/GM/

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796